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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/042,416	01/08/2002	Michael Joseph Calderaro	AUS920010789US1	1319
40412	7590	03/23/2006	EXAMINER	
IBM CORPORATION- AUSTIN (JVL) C/O VAN LEEUWEN & VAN LEEUWEN PO BOX 90609 AUSTIN, TX 78709-0609			KRISCIUNAS, LINDA MARY	
			ART UNIT	PAPER NUMBER
			3623	

DATE MAILED: 03/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/042,416

Applicant(s)

CALDERARO ET AL.

Examiner

Linda Krisciunas

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. This is a Non-Final Office Action in response to the Application filed January 8, 2002. Claims 1-20 are pending.

#### ***Double Patenting***

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-2, 4-9, 11-15 and 17-20 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-20 of copending Application No. 10042415.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

3. The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows:

Claims 1, 8 and 14 of application 10042416 lists employees, whereas claims 1, 8 and 14 of application 10042415 list human resources. An employee is an example of a human resource.

Claims 2, 9 and 15 of application 10042416 list data records, whereas claims 2, 9 and 15 of application 10042415 list employee data records. The terms are both types of data records.

Claims 4, 11 and 17 of application 10042416 list low skill evaluation, whereas claims 3 and 16 of application 10042415 lists skill level. A skill evaluation would produce a skill level value.

Claims 5, 12 and 18 of application 10042416 list surplus employees' data records and skill group, whereas claims 4, 10, 17, 6, 12 and 19 of application 10042415 list template and surplus group of employees and criteria. The data records are deemed equivalent to a template as they perform an identical function in substantially the same manner with substantially the same results. The skill group is a criteria for comparison.

Claims 6 and 19 of application 10042416 lists applicable laws, whereas claims 7, 13 and 20 of application 10042415 list local, national and state laws. The terms state, local and national are all types of applicable laws.

Claims 7, 13 and 20 of application 10042416 list statistical analyses, whereas claims 5, 11 and 18 of application 10042415 does not list statistical analyses. Elimination of an element or its functions - *In re Karlson*, 136 USPQ 184, 186; 311 F2d 581 (CCPA 1963)

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 4-5, 7-8, 11-14, 17-18 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by US Office of Personnel Management (OPM), Restructuring Information Handbook Module 3, Reduction in Force (June 1998) (referred to herein after as OPM).

As per claims 1, 8 and 14, OPM teaches receiving a skill group identifier (See page 11, section 5 where the competitive levels are based upon similarity of grade, duties, qualifications etc. Each of these would be a skill group identifier.); retrieving data records for a plurality of employees, wherein each data record includes the skill group identifier and an evaluation (See page 14, section d, where performance ratings are provided. A performance rating is equivalent to an evaluation as it performs an identical function in substantially the same manner with effectively the same results); comparing the retrieved data records based upon the corresponding evaluations (See page 12, section 6, where the name of each employee is listed on the retention register in order of standing. The employees are compared according to the retention value, where they are subsequently listed in order.); and identifying one or more surplus employees based upon the comparisons (See page 15, section 8, where employees are released from the retention register in the inverse order of their standing (ie lowest standing is released first) for reduction in force. If the employee is not retained then they are deemed to be equivalent to being surplus as it performs an identical function in substantially the same manner with effectively the same results.).

As per claims 4, 11 and 17, OPM teaches identifying the evaluation as a low skill evaluation (See page 11, section 5, where the evaluations cover all aspects including qualifications and a rating is provided for each category); and checking whether the employee's data record includes one or more positive employment factors, wherein at least one of the positive employment factors is selected from the group consisting of a top contributor indicator, a stock option award, a significant salary increase, a critical

skill identifier, and a promotion identifier (See page 14, section d, where the past performance reviews are evaluated and various credits are given for various levels of performance. "Outstanding" performances meriting more credit than "exceeds fully successful" etc. where these would constitute a top contributor indicator. ).

As per claims 5, 12 and 18, OPM teaches assessing the surplus employees' data records with one or more corporate surplus guidelines (The OPM Restructuring Information Handbook is to be used as a guide when reduction in workforce situations arise); assessing each of the surplus employees' evaluations to other employee evaluations having the same skill group (See page 11, section 5 where the competitive levels are based upon similarity of grade, duties, qualifications etc. Each of these would be a skill group identifier and given a retention value. See page 12, section 6, where the name of each employee is listed on the retention register in order of standing. The employees are compared according to the retention value, where they are subsequently listed in order.); and rejecting one or more of the surplus employee identifications based upon one of the assessments (See page 10, section f, where in lieu of reduction in force (RIF) the agency may reassign an employee to another position. This is equivalent to rejecting one as a surplus employee as it performs an identical function in substantially the same manner with substantially the same results.).

As per claims 7, 13 and 20, OPM teaches comparing the surplus employees' data records with data records corresponding to non-surplus employees (See page 12, section 6, where the name of each employee is listed on the retention register in order of standing. The employees are compared according to the retention value, where they

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are subsequently listed in order. See page 15, section 8, where employees are released from the retention register in the inverse order of their standing (ie lowest standing is released first) for reduction in force. If the employee is not retained then they are deemed to be equivalent to being surplus as it performs an identical function in substantially the same manner with substantially the same results); creating one or more statistical analyses based on the comparison, wherein the statistical analyses include one or more protected employment factors (See page 13 where tenure groups are made and veteran's preference subgroups are made); assessing the statistical analyses using one or more applicable laws (See page 13 where the Dual Compensation Act of 1964 is used to qualify veteran status); and modifying the group of identified surplus employees based on the assessment (See page 13 where there is an assessment made as to whether or not the employee qualifies for protection under the veteran status if they meet the listed criteria of combat-incurred disability or injury, years of service, length of service etc).

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.



7. Claims 2, 9 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Office of Personnel Management (OPM), Restructuring Information Handbook Module 3, Reduction in Force (June 1998) (referred to herein after as OPM) in view of "IT confidential" by John Soat, InformationWeek, July 9, 2001.

As per claims 2, 9 and 15, OPM teaches sorting the retrieved data records based on the corresponding evaluations (See page 12, section 6, where the name of each employee is listed on the retention register in order of standing. The names are sorted according to retention value.); selecting the surplus number of employees from the lower end of the sorted data records (See page 15, section 8, where employees are released from the retention register in the inverse order of their standing (ie lowest standing is released first) for reduction in force. If the employee is not retained then they are deemed to be equivalent to being surplus as it performs an identical function in substantially the same manner with substantially the same results). OPM does not explicitly teach using a percentage to determine the surplus number. Soat teaches that it is known to retrieve a surplus percentage corresponding to the skill group identifier; multiplying the surplus percentage by the number of retrieved data records creating a surplus number (See paragraphs 4-5, where routine house cleaning consists of taking stock of the skill base and phasing out those not in demand. The management consulting unit reduced 9% of the workforce from this unit, or 400 people.) Soat is an analogous art as it also teaches about surplus employees. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the

surplus employee system of OPM with the percentage feature of Soat to provide a more user-friendly method of calculating the surplus number.

8. Claims 3, 10 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over OPM in view of "Are you really managing your corporate resources?" by Robert Skinner, Management Accounting, August 1998.

As per claims 3, 10 and 16, OPM teaches analyzing one of the evaluations prior to the comparing (See page 14, section d, where the three annual performance ratings are received and credit is provided for past ratings.). OPM does not explicitly teach agreement and re-work of evaluations. Skinner teaches that it is known to determine whether to agree with the evaluation (See page 6, paragraphs 7-8, where a draft review is performed and discussed between the manager and employee and feedback is provided as to what is agreed upon and what is not.); and sending a rework request to a creator of the evaluation in response to not agreeing with the evaluation (See page 6, paragraphs 7-8, where after the draft evaluation review, the draft is updated or re-worked and a final evaluation is made.). Skinner is an analogous art as it also teaches about managing resources. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the resource management system of OPM with the evaluation re-work and agreement features of Skinner to provide a more efficient and comprehensive evaluation system.

9. Claims 6 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over OPM.

As per claims 6 and 19, OPM teaches reviewing each of the surplus employees' data records using one or more applicable laws (See page 9, section 1: OPM guidelines are part of the Code of Federal Regulations 5 CFR 351 which is based upon federal law.). OPM does not explicitly teach determining an additional compensation amount for one or more of the surplus employees based on the applicable laws; and adding the additional compensation to a severance amount corresponding to the surplus employees. Official notice is taken that it is old and well known to provide a severance package to employees that are separated from a company which would include any separate monies associated with years of service etc. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to provide a severance package to separated employees to provide a means of compensating the employee for past service.

### ***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following art also teaches employee management: Calderaro et al (US 2003/0004790), Calderaro et al (US 2003/0004789), Williams et al (US 6,618,734), Fethe (US 5,926,794), Dirksen et al (US 6,853,975), Havens (US 5,909,669), "Reduction in grade and removal based on unacceptable performance", 5 CFR Part 432, February 23, 1987; "National Institute of Standards and Technology", Alternative Personnel Management System, Federal Register, October 21, 1997, v62, n203; and "Department of the Navy, Human Resources Implementation Guide" by Betty Welch, Department of the Navy Performance Management Programs, October 1, 1997.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Linda Krisciunas whose telephone number is 571-272-6931. The examiner can normally be reached on Monday through Friday, 6:30 am to 3:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on 571-272-6729. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

LMK

*LMK*  
*March 15, 2006*

*Susanna Diaz*  
**SUSANNA M. DIAZ**  
**PRIMARY EXAMINER**

*AU 3623*